



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/746,901 11/18/96 ELLIOTT

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EXAMINER

LM02/0606

MCIWORLD.COM
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Washington DC 20036

NGUYEN, S

ART UNIT

PAPER NUMBER

2731

DATE MAILED:

06/06/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action

Application No.
08/746,901

Applicant(s)
Elliot

Examiner
Steven Nguyen

Group Art Unit
2731



THE PERIOD FOR RESPONSE: [check only a) or b)]

- a) ☐ expires _____ months from the mailing date of the final rejection.
- b) ☒ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☐ Appellant's Brief is due two months from the date of the Notice of Appeal filed on _____ (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on May 22, 2000 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

- ☒ The proposed amendment(s):
- ☒ will be entered upon filing of a Notice of Appeal and an Appeal Brief.
- ☐ will not be entered because:
- ☐ they raise new issues that would require further consideration and/or search. (See note below).
 - ☐ they raise the issue of new matter. (See note below).
 - ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
 - ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: _____

- ☐ Applicant's response has overcome the following rejection(s): _____
- _____

- ☐ Newly proposed or amended claims _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.

- ☐ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____
- _____

- ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

- ☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: _____

Claims objected to: _____

Claims rejected: 19-30

- ☐ The proposed drawing correction filed on _____ ☐ has ☐ has not been approved by the Examiner.

- ☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

- ☒ Other *see attachment sheets*.

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DETAILED ACTION

Specification

1. Due to the numerous changes to the specification as requested by the Amendment A filed 10/18/1999, those changes have not been amended. A substitute specification or pages of the specification with such changes is/are required.

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and must be accompanied by: 1) a statement that the substitute specification contains no new matter; and 2) a marked-up copy showing the amendments to be made via the substitute specification relative to the specification at the time the substitute specification is filed.

Response to Arguments

2. Applicant's arguments filed 5/24/2000 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *Like a router*,

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each of the network interfaces in the switch 221 is labeled with a subnet address. Internet Protocol (IP) addresses contain the subnet address on which the computer is located. PSTN addresses do not contain IP subnet addresses, so subnets are mapped to PSTN area codes and exchanges. The switch 221 selects routes to IP addresses and PSTN addresses by selecting an interface to a subnet which will take the packets closer to the destination subnet or local switch.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Page 5-7 of the response, the applicant states that Yang or Kubler does not translate an identifier of a destination of the call from a list of telephone numbers and associated Internet protocol addresses in the directory service. In reply, Yang discloses the directory Servers being the main philosophy behind the INETPhone service is to reduce a long distance phone call into two local calls and an Internet connection. Therefore, an INETPhone server will always be identified by its IP address with its local area code of the phone number (also possibly with its sub-regional number). In order to support a dynamic configuration of INETPhone servers on the Internet, a Directory Server(s) (DS) will be required to map between IP address and area code of INETPhone servers, which in some sense, is similar to the functions of a Name Server. After an INETPhone server is installed on the Internet, it needs to register itself with a DS. The mapping information at DS will be disseminated to INETPhone servers for the search of a remote server in response to a requested phone call. Local cache of mapping information may also be maintained

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at INETPhone servers to alleviate communications between INETPhone servers and Directory Server(s). Thus Yang discloses a method of translating an identifier of destination of the call such as region or country code with a list of telephone numbers and associated IP addresses which is stored in the database of directory server in order to obtain the gateway for routing the call. Furthermore, Kubler discloses a method of translating an identifier of destination of the call such as region or country code with a list of telephone numbers and associated IP addresses which is stored in the database of directory server in order to obtain the gateway for routing the call (See col 101, lines 42 to col 102, lines 8).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Yang and Kubler disclose the packets being transmitting via Internet by using a well known in the art and widely using in the public as Internet Protocol such as TCP/IP, UDP which includes Ping, trace route, packet echo and packet latency command as disclosed in Williams et al col 3, lines 8-48 (USP 5883891), Nelson et al Fig 3, Ref 108 (USP 5835720), McKee et al col 1, lines 22-56 (USP 5477531) and Ranganathan et al Fig 3-4, col 6, lines 43 to col 7, lines 50 (USP 5931961) which are provided to the applicant in the first and final office

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action. These utilities use for diagnostic the computer network such as Internet. Therefore, applying this diagnostic utility into Internet to determine would have been explicit to one of ordinary skill in the art if a node is a live or not, time delay etc . . .

The teaching of Yang, Kubler and a well known TCP/IP diagnostic utility perform the claimed invention. Thus, the rejection maintains.

Conclusion


3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Nguyen whose telephone number is (703) 308-8848. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi Pham, can be reached on (703) 305-4378.

The fax phone number for this group is (703) 305-3988.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Steven Nguyen
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June 2, 2000


CHI H. PHAM
SUPERVISORY PATENT EXAMINER
GROUP 2700 6/5/00